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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/468,611	12/21/1999	ERIC B. REMER	42390.P7278	3835

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EXAMINER

HAYES, JOHN W

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 10/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/468,611

Applicant(s)

REMER ET AL.

Examiner

John W Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9,10,13,25,27-29 and 31-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,9,10,13,25,27-29 and 31-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08 September 2003 has been entered.

Status of Claims

2. Applicant has amended claims 1 and 13 in the amendment filed on 11 August 2003. Applicant has previously canceled claims 3, 8, 11-12, 14-24, 26 and 30. Thus, claims 1-2, 4-7, 9-10, 13, 25, 27-29 and 31-34 remain pending and are presented for examination.

Response to Arguments

3. Applicant's arguments filed 11 August 2003 have been fully considered but are not persuasive or moot in view of the discussion below and the new grounds of rejection.

4. Examiner agrees with applicant's argument that Misra discloses a license server that determines whether the client is authentic and grants a new license if the client is authentic. Applicant also asserts that Misra does not disclose determining, by the first computer, whether a second license is authentic. Examiner respectfully disagrees with this assertion and notes that Misra discloses that the license server digitally signs the software license and encrypts it using the client's public key suggesting that the digital signature is used to authenticate the license server as well as the license. Furthermore, examiner submits that it was a well known practice in the encryption art at the time of applicant's claimed invention to use digital signatures and hashing functions to authenticate the origin of digital information as well as authenticating the actual information to ensure that the information has not been altered or tampered with.

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In this case, the digital signature applied to the software license as disclosed by Misra et al (Col. 15, lines 37-50) is used to ensure that it cannot be maliciously utilized or modified by the intermediate server, thereby authenticating the license. As stated above, it is well known in the art to also utilize hashing algorithms to authenticate information to ensure that it has not been altered or tampered with.

5. Applicant's arguments with respect to the Gradient and Bains references are moot based on the new grounds of rejection.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2, 4-7, 9-10, 13, 25, 27-29 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al, U.S. Patent No. 6,189,146 B1 in view of Gradient, "Gradient Introduces End User Software License Creation and Delivery Tool For Its iFOR/LS Licensing Technology, dated 21 March 1994 and Bains et al, U.S. Patent No. 5,579,222.

As per **Claims 1, 13 and 33-34**, Misra et al discloses a method for licensing software comprising:

- generating a first license for software installed on the first computer (Col. 2, lines 62-67; Col. 3, lines 22-25; Table 1; Col. 11, lines 45-51; Col. 12, lines 8-14);
- obtaining, by a first computer, from a second computer a second license for software installed on the first computer, wherein the second license is generated by the second computer (Col. 2, lines 48-55; Col. 4, lines 54-59; Col. 8, lines 35-67; Col. 12, lines 20-27; Col. 14, lines 8-14 and 49-53);
- determining, by the first computer, whether the second license is authentic (Col. 15, lines 29-49), and

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- replacing, if the second license is authentic, the first license with the second license (Col. 15, lines 37-49; Col. 16, lines 49-67);

- selectively refreshing the second license prior to expiration of the second predetermined period of time (Col. 14, lines 14-51; Col. 16, lines 49-67).

Misra et al discloses the generation of a first license on a license generator computer which is the same license generator that generates the second license as well, however, fail to explicitly disclose that a first computer generates the first license. Horstmann discloses a method for relicensing of electronically purchased software and teach that the end user machine stores a license certificate that describes license policies which are then followed by the relicensing manager. Horstmann further discloses that the license certificate is stored on the end user's machine during installation (Col. 3, lines 10-17 and 59-64). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Misra et al and include the ability to generate the license on the first computer in response to the software being installed as taught by Horstmann. Horstmann provides motivation by indicating that the first computer is then able to relicense the installed software on the same machine or even a different machine, if necessary, by referring to the license certificate stored on the end user's computer and requesting to relicense the software.

As per **Claims 2 and 25**, Misra et al further disclose

- setting, by the first computer, a first identifier to associate the first license with the first computer (Col. 9, lines 29-61; Col. 10, lines 51-59; Col. 12, lines 41-67);

- matching the unique identifier of the second license to the unique identifier of the first license, and if no matching occurs, discarding the second license without replacing the first license (Col. 11, lines 45-65; Col. 11 line 66-Col. 12 line 7; Col. 14, lines 30-39), and

- authenticating the digital signature of the second license, and if authentication fails, discarding the second license without replacing the first license (Col. 12, lines 8-15);

- replacing the first license with the second license if the second license is determined to be authentic (Col. 16, lines 39-67).

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As per Claims 10 and 32, Misra et al further disclose wherein the first and second licenses are digitally signed (Col. 13, lines 42-63; Col. 14, lines 25-38).

As per Claims 4 and 27, Misra et al further disclose wherein obtaining from the second computer the second license further comprises:

- connecting to the second computer (Col. 14, lines 14-16)
- providing the second computer with at least some of the data from the first license (Col. 14, lines 24-30)
- exchanging the provided data from the first license for the second license (Col. 14, lines 49-53; Col. 15, lines 11-18 and 37-49).

As per Claims 5-6 and 28-29, Misra et al further disclose wherein connecting to the second computer comprises connecting to the second computer via a communications network (Col. 4, lines 43-49).

As per Claim 7, Misra et al disclose all the limitations of claim 5, however, fail to specifically disclose wherein exchanging the first license for the second license includes formatting data from the first license according to a set of text processing rules and transmitting the formatted data using a text transfer protocol. Examiner takes Official Notice that formatting data according to a set of text processing rules such as HTML or XML and transmitting the formatted data using a text transfer protocol such as HTTP was well known in the art at the time of applicants invention. Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use text processing rules such as HTML for formatting data and use a text transfer protocol such as HTTP for exchanging data since these formats and protocols were commonly used, especially in Internet communications since they were readily available and convenient to use.

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As per Claims 9 and 31, Misra et al disclose verifying whether the replaced license is valid, including determining whether the replaced license has expired (Col. 14, lines 30-48).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Ross et al disclose a method and apparatus for electronic licensing in a network environment to facilitate product licensing and upgrades
- Coley et al [2002/0161718] disclose an automated system for management of licensed software and enabling or disabling the software accordingly and further teach that software can be pre-enabled with a temporary term license
- Griswold discloses a license management system that periodically invokes a license check monitor to ensure valid usage of software and terminates use of the software is appropriate
- Horstmann discloses a method of relicensing of electronically purchased software
- Knutson discloses a method for licensing computer programs using DSA signature
- Carter et al disclose a method for network license authentication
- Cohen discloses a method for software licensing electronically distributed programs

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:


***Commissioner of Patents and Trademarks
Washington D.C. 20231***

or faxed to:

(703) 872-9306 [Official communications; including
After Final communications labeled
"Box AF"]

(703) 746-5531 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington,
VA, 7th floor receptionist.


John W. Hayes
Primary Examiner
Art Unit 3621

October 27, 2003